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**FACSIMILE TRANSMISSION**

DATE: April 21, 2006

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| Examiner Daniel I. Walsh -<br>U.S. Patent and Trademark Office | 571-273-8300 | 571-272-2800 |

FROM: Kirk Dorius

PHONE: 602-382-6544

RE:

MESSAGE:

Attached is the Terminal Disclaimer for Serial No. 10/710,332

|                    |                  |                                    |              |
|--------------------|------------------|------------------------------------|--------------|
| ORIGINAL DOCUMENT: | Will not be sent | NUMBER OF PAGES (Including Cover): | 6            |
| CONFIRMATION NO.:  |                  | CLIENT MATTER NO.:                 | 70655.3000   |
| PLEASE RETURN TO:  | S.Bowman/16S02   | PERSONAL FAX:                      | No           |
| REQUESTOR:         | Kirk Dorius      | DIRECT LINE:                       | 602-382-6544 |

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PAGE 1/26 \* RCVD AT 4/21/2006 6:41:03 PM [Eastern Daylight Time] \* SVR:USPTO-EFXRF-2/19 \* DNI:2738300 \* CSID:602 382 6070 \* DURATION (mm:ss):08:02

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PTO/SB/21 (09-04)

Approved for use through 07/31/2008. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

|                        |                         |
|------------------------|-------------------------|
| Application Number     | 10/710,332              |
| Filing Date            | July 1, 2004            |
| First Named Inventor   | David S. Bonita, et al. |
| Art Unit               | 2878                    |
| Examiner Name          | Daniel I. Walsh         |
| Attorney Docket Number | 70655.3000              |

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|--|---|---|
| <input checked="" type="checkbox"/> Fee Transmittal Form   | <input type="checkbox"/> Drawing(s)                                       | <input type="checkbox"/> After Allowance Communication to TC                            |
| <input type="checkbox"/> Fee Attached  | <input type="checkbox"/> Licensing-related Papers                         | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences     |
| <input type="checkbox"/> Amendment/Reply   | <input type="checkbox"/> Petition   | <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final   | <input type="checkbox"/> Petition to Convert to a Provisional Application | <input type="checkbox"/> Proprietary Information  |
| <input type="checkbox"/> Affidavits/declaration(s)   | <input type="checkbox"/> Power of Attorney, Revocation                    | <input type="checkbox"/> Status Letter  |
| <input type="checkbox"/> Extension of Time Request   | <input type="checkbox"/> Change of Correspondence Address                 | <input type="checkbox"/> Other Enclosure(s) (please identify below):                    |
| <input type="checkbox"/> Express Abandonment Request   | <input checked="" type="checkbox"/> Terminal Disclaimer                   |   |
| <input type="checkbox"/> Information Disclosure Statement  | <input type="checkbox"/> Request for Refund                               |   |
| <input type="checkbox"/> Certified Copy of Priority Document(s)                                    | <input type="checkbox"/> CD, Number of CD(s) _____                        |   |
| <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application                            | <input type="checkbox"/> Landscape Table on CD                            |   |
| <input type="checkbox"/> <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 |   |   |
|  | <b>Remarks</b>  |   |

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

|              |   |          |        |
|--------------|---|----------|--------|
| Firm Name    | SNELL & WILMER, LLP, 400 East Van Buren, Phoenix, Arizona 85004-2202                |          |        |
| Signature    |  |          |        |
| Printed name | Kirk Dorius   |          |        |
| Date         | April 21, 2006  | Reg. No. | 54,073 |

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

|                       |   |      |                |
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| Signature             |  |      |                |
| Typed or printed name | Sheila Bowman   | Date | April 21, 2006 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

**FEE TRANSMITTAL**  
**For FY 2006** Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)

130.00

Complete If Known

|                      |                          |
|----------------------|--------------------------|
| Application Number   | 10/710,332               |
| Filing Date          | July 1, 2004             |
| First Named Inventor | David S. Bonalle, et al. |
| Examiner Name        | Daniel I. Walsh          |
| Art Unit             | 2876                     |
| Attorney Docket No.  | 70655.3000               |

**METHOD OF PAYMENT** (check all that apply)

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**FEE CALCULATION** (All the fees below are due upon filing or may be subject to a surcharge.)**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

| Application Type | FILING FEES |              | SEARCH FEES |              | EXAMINATION FEES |              | Fee Paid (\$) |
|------------------|-------------|--------------|-------------|--------------|------------------|--------------|---------------|
|                  | Fee (\$)    | Small Entity | Fee (\$)    | Small Entity | Fee (\$)         | Small Entity |               |
| Utility          | 300         | 150          | 500         | 250          | 200              | 100          |               |
| Design           | 200         | 100          | 100         | 50           | 130              | 65           |               |
| Plant            | 200         | 100          | 300         | 150          | 160              | 80           |               |
| Reissue          | 300         | 150          | 500         | 250          | 600              | 300          |               |
| Provisional      | 200         | 100          | 0           | 0            | 0                | 0            |               |

**2. EXCESS CLAIM FEES**Fee Description

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

| Total Claims  | Extra Claims | Fee (\$) | Fee Paid (\$) | Multiple Dependent Claims |          |
|---|--------------|----------|---------------|---------------------------|----------|
|   |              |          |               | Fee (\$)                  | Fee (\$) |
| - 20 or HP =  | x            | =        |               | 50                        | 25       |
| HP = highest number of total claims paid for, if greater than 20. |              |          |               | 200                       | 100      |

| Indep. Claims | Extra Claims | Fee (\$) | Fee Paid (\$) | Multiple Dependent Claims |               |
|---------------|--------------|----------|---------------|---------------------------|---------------|
|               |              |          |               | Fee (\$)                  | Fee Paid (\$) |
| - 3 or HP =   | x            | =        |               |                           |               |

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**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(c)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets      Extra Sheets      Number of each additional 50 or fraction thereof

Fee (\$)      Fee Paid (\$)

- 100 =      / 50 =      (round up to a whole number) x      =      Fee Paid (\$)

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Terminal Disclaimer      130.00

**SUBMITTED BY**

|                   |             |   |                          |
|-------------------|-------------|---|--------------------------|
| Signature         | Kirk Dorlus | Registration No. 54,073<br>(Attorney/Agent) | Telephone (602) 382-6544 |
| Name (Print/Type) | Kirk Dorlus | Date April 21, 2006                         |                          |

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Date: April 21 2006By: L.S. BonalleIN THE UNITED STATES PATENT AND TRADEMARK OFFICEPATENT

|              |  |                 |                         |
|--------------|--|-----------------|-------------------------|
| Inventors:   | <b>David S. Bonalle, et al.</b>                                  | Docket No.:     | <b>70655.3000</b>       |
| Serial No.:  | <b>10/710,332</b> Confirmation No.:<br><b>4331</b>               | Group Art Unit: | <b>2876</b>             |
| Filing Date: | <b>July 1, 2004</b>  | Examiner:       | <b>Walsh, Daniel I.</b> |
| Title:       | <b>METHOD FOR REGISTERING BIOMETRIC FOR USE WITH A SMARTCARD</b> |                 |                         |

**TERMINAL DISCLAIMER TO OBLIGATE  
A PROVISIONAL DOUBLE PATENTING REJECTION  
OVER CO-PENDING APPLICATION**

Mail Stop Amendment  
Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Commissioner:

The owner, American Express Travel Related Services Company, Inc., of 100% interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on the pending reference Application Number 10/710,331 which was filed on July 1, 2004 and Application Number 10/708,839 which was filed on March 26, 2004, as such term is defined in 35 U.S.C. §§ 154 and 173, and as the term of any patent granted on said reference applications may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending reference applications. The owner hereby

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AmExp. 200501333  
1824114.1

Serial No. 10/710,332  
Attorney Docket No. 70655.3000

agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the reference applications are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 and 173 of any patent granted on said reference application, "as the term of any patent granted on said reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending reference application," in the event that any such patent granted on the pending reference application: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

The undersigned is an attorney of record, Reg. No. 54,073.

Serial No. 10/710,332  
Attorney Docket No. 70855.3000

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814.

Respectfully submitted,

Dated: April 2/2006

By: Kirk Dorius  
Kirk Dorius  
Reg. No. 54,073

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